

REMARKS

This paper responds to the Decision on Appeal dated September 3, 2010. Claims 15-22 are presently amended. Claims 1-14 and 23-34 were previously canceled, and no claims are canceled herein. Claims 35-45 are added. As a result, claims 15-22 and 35-45 are now pending in this application.

Claim Amendments

Claim 15 is presently amended to recite, in part, “**the identifying of the at least one frequently used search term being based on a number of times the at least one frequently used search term is submitted within a period of time to the network-based commerce system.**”¹ Support for this amendment is found in Applicants’ specification, for example, in at least paragraph 0050.² Applicants respectfully submit that this claim limitation is not found in the art cited as a basis of rejection. Thus, Applicants respectfully request that this amendment be entered and that the amended claims be considered and allowed.

Claim Rejections Under 35 U.S.C. § 102

The Decision on Appeal affirmed the rejections of claims 15-22, which were rejected in the Final Office Action dated July 15, 2009.³ The Final Office Action rejected claims 15-22 under 35 U.S.C. § 102(a) as allegedly being anticipated by Spiegel (U.S. Patent 6,466,918).⁴

To anticipate a claim, a reference must disclose **each and every element** of the claim,⁵ as arranged in the claim,⁶ and in as complete detail as in the claim.⁷ Moreover, inherency of a

¹ Emphasis added.

² Specification at paragraph 0050, “a determination may be made as to whether the popular search term has been attempted or used a predetermined **number of times (e.g., 10,000)** within a designated or selected period of time (e.g., the previous two weeks),” emphasis added.

³ Decision on Appeal at 5.

⁴ Final Office Action at 4.

⁵ “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed Cir. 1987), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential), emphasis added.

⁶ “To establish anticipation, every element and limitation of the claimed invention must be found in a single prior art reference, **arranged as in the claim.**” *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383; 58

claim element “requires that the missing descriptive material is ‘**necessarily present**,’ not merely **probably** or **possibly** present, in the prior art.”⁸ “The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient.”⁹

Independent claim 15 recites a “**frequently used search term**.”¹⁰ The Decision on Appeal agreed with the Final Office Action that “Speigel’s categories name **categories** within which products may be searched, and so would be frequently used search terms.”¹¹ Applicants respectfully submit that Spiegel does not disclose a “frequently used search term,” at least because a search term is not **necessarily** a category, and a category is not **necessarily** a search term, much less a frequently used search term. The mere fact that a search term **may** result in a category being searched is not sufficient to establish anticipation. Similarly, although the Decision on Appeal stated that “Spiegel describes using **products** in search terms,”¹² a search term is not **necessarily** a product, and a product is not **necessarily** a search term. The mere fact that a search term **may** result in a product being used is not sufficient to establish anticipation. Furthermore, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”¹³ Nothing in Spiegel describes anything as being “**frequently used**,” let alone a category or a product as being “**frequently used**,” as recited in claim 15. Spiegel contains no discussion whatsoever of **frequency of use** with respect to anything, let alone with respect to **search terms**. Thus, Spiegel does not and cannot disclose a **frequently used search term**.

U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential), emphasis added.

⁷ “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), cited in MPEP § 2131, emphasis added.

⁸ *In re Robertson*, 169 F.2d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999), citing *Continental Can Co. USA, Inc., v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991), emphasis added.

⁹ *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981), emphasis added; see also *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (BPAI 1986) (“[T]he Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the Examiner’s belief that the functional limitation is an **inherent** characteristic of the prior art” before the burden is shifted to the Applicant to disprove inherency,” emphasis added).

¹⁰ Emphasis added.

¹¹ Decision on Appeal at 5, emphasis added.

¹² *Id.*, emphasis added.

¹³ *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970), emphasis added; see MPEP § 2143.03.

Nonetheless, to further distinguish over Spiegel, independent claim 15 is presently amended to recite, in part, **“the identifying of the at least one frequently used search term being based on a number of times the at least one frequently used search term is submitted within a period of time to the network-based commerce system.”**¹⁴ Nothing in Spiegel is described as being identified based on a number of times it is submitted within a period of time to a network-based commerce system. As noted above, Spiegel makes no mention of a frequently used search term. Hence, Spiegel does not and cannot disclose **identifying a frequently used search term based on a number of times the frequently used search term is submitted within a period of time to a network-based commerce system**. Thus, Spiegel fails to disclose at least this claim element.

Because **each and every element** of independent claim 15 is not disclosed in the cited reference, as arranged in the claims, and in as complete detail as in the claims, no *prima facie* case of anticipation is established with respect to independent claim 15. For at least these reasons, independent claim 15, and its dependent claims 16-22, are patentable over the cited reference. Moreover, the dependent claims may each be patentable based on elements recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

New Claims

Claims 35-36 are new. Support for these new claims is found in Applicants' specification, for example, in at least paragraph 0027.¹⁵

Claims 37-39 are new. Support for these new claims is found in Applicants' specification, for example, in at least FIG. 4A and paragraph 0045.¹⁶

¹⁴ Emphasis added.

¹⁵ Specification at paragraph 0027, “The phrase ‘**frequently used search term**’ is intended to include, for example, terms that are **frequently entered by users** when conducting searches for listings. The frequently used search terms need not be limited to terms used in a **specific network-based commerce facility or system** but may include **terms used in other facilities**,” emphasis added.

¹⁶ *Id.* at paragraph 0045, “The Popular Search Term table 70 is shown, by way of example, to include a **Search_Term** field, a **Date_Of_Entry** field, a **Time_Of_Entry** field, and a **Site_ID** field,” emphasis added.

Claims 40-41 are new. Support for these new claims is found in Applicants' specification, for example, in at least FIG. 4B and paragraph 0046.¹⁷

Claims 42-43 are new. Support for these new claims is found in Applicants' specification, for example, in at least FIG. 4C and paragraph 0047.¹⁸

Claim 44 is new. Support for this new claim is found in Applicants' specification, for example, in at least FIG. 3A-3B and 13 and paragraphs 0041-0044 and 0093-0095.¹⁹

Claim 45 is new. Support for this new claim is found in Applicants' specification, for example, in at least FIG. 13 and paragraph 0095.²⁰

Applicants respectfully submit that limitations recited in the new claims are not found in the art cited as a basis of rejection. Thus, Applicants respectfully request that the new claims be entered, considered, and allowed.

¹⁷ *Id.* at paragraph 0046, "The Popular Search Term Ranking table 80 is shown, by way of example, to include a **Rank** field, a **Search_Term** field, a **Searches_Attempted** field, and a **Site_ID** field," emphasis added.

¹⁸ *Id.* at paragraph 0047, "an exemplary Popular Search Term list 88 that illustrates an example of the contents of the Popular Search Term Ranking table 80 The first column . . . provides a **Rank** 90 associated with the popular search terms The third column provides a **Number of Searches** 94 attempted at the network-based commerce system 10 (or a multiple different systems) using the popular search terms 90, for example, within a predetermined amount of time (e.g., the last 2 weeks)," emphasis added.

¹⁹ *See e.g., id.* at paragraph 0043, "The popular search term presentation logic 74 includes a popular search term category identification module 75, an assigned popular search term retrieval module 76, a popular search term listing identification module 77, and a popular search term display module 78," emphasis added; *see also, e.g., id.* at paragraph 0093, "FIG. 13 shows a diagrammatic representation of a machine in the exemplary form of a computer system 200 within which a set or sequence of instructions, for causing the machine to perform any one of the methodologies discussed above, may be executed," emphasis added.

²⁰ *See e.g., id.* at paragraph 0095, "a machine-readable medium 220 on which is stored a set of instructions or software 204 embodying any one, or all, of the methodologies described above," emphasis added.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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9-30-2010

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30 day of September, 2010.

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